



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/495,459	02/01/2000	Hanna Abi-Saleh	9826-032-999	4881

24341 7590 10/05/2004

MORGAN, LEWIS & BOCKIUS, LLP.
2 PALO ALTO SQUARE
3000 EL CAMINO REAL
PALO ALTO, CA 94306

EXAMINER

BRINICH, STEPHEN M

ART UNIT PAPER NUMBER

2624

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

Address : COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---------------------------------------------------	---------------------

EXAMINER

ART UNIT	PAPER
----------	-------

20040923

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Office Action Summary	Application No. 09/495,459	Applicant(s) ABI-SALEH ET AL.	
	Examiner Stephen M Brinich	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Art Unit: 2624

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-5, 7-20, & 22-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Dobbs in view of Koppolu et al.

Re claims 1, 4-5, 7, 9, 12, 14-15, 17, 20, & 22-23, Dobbs discloses (column 2, lines 12-61) a computer processor and printer arrangement that generates a test data structure (i.e. a test pattern and associated icon) for testing a printer driver by opening the associated application (the print driver) in the computer memory and a document (the test pattern) in order to produce a test print from the test data structure.

Dobbs does not disclose the use of information in a registry database to associate applications and documents. The use of a registry database to associate a plurality of applications with respective documents is known in the art as

Art Unit: 2624

disclosed by the Koppolu et al description (column 1, lines 59-63) of the Windows 95™ registry.

Dobbs and Koppolu et al are combinable because they are from the field of accessing documents stored as computer-readable files and printing them on a printer.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a registry database to associate applications and documents in the printer driver test arrangement of Dobbs.

The suggestion/motivation for doing so would have been in order to permit documents of various file formats to be used as test patterns.

Therefore, it would have been obvious to combine Dobbs with Koppolu et al to obtain the invention as specified in claims 1, 4-5, 7, 9, 12, 14-15, 17, 20, & 22-23.

Re claims 2, 10, & 18, Dobbs further discloses (column 3, lines 22-23) the selection of one of several print options.

Re claims 3, 11, & 19, the described user-selected icon (column 2, lines 54-55) is inherently a component of a graphical user interface.

Re claims 8, 16, & 24, Dobbs further discloses (column 3, lines 27-31) the generation and recording of a compatible print mode log.

Art Unit: 2624

Re claim 13, Dobbs further discloses (column 2, line 62 - column 3, line 10), an auto-learning arrangement whereby the printer driver is equipped with learned controls corresponding to particular print media types.

3. Claims 6 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobbs in view of Koppolu as applied to claims 1-5, 7-20, & 22-24 above, and further in view of Weinberger.

Re claims 6 & 21, Dobbs further discloses (column 2, line 62 - column 3, line 10), an auto-learning arrangement whereby the printer driver is equipped with learned controls corresponding to particular print media types.

Dobbs discloses the use of a single printer driver. The use of multiple installed printer drivers on a computer system and the selection of a printer driver for a given print job is well known in the art as shown for example by Weinberger (column 4, lines 24-29).

Dobbs in view of Koppolu et al and Weinberger are combinable because they are from the field of accessing documents stored as computer-readable files and printing them on a printer.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use one of a set of multiple printer drivers.

Art Unit: 2624

The suggestion/motivation for doing so would have been in order to allow the use of multiple printers connected to a single computer

Therefore, it would have been obvious to combine Dobbs in view of Koppolu et al with Weinberger to obtain the invention as specified in claims 6 & 21.

Response to Arguments

4. Applicant's arguments filed 7/9/04 have been fully considered but they are not persuasive.

Applicant argues (7/9/04 Response: page 8, lines 22-27) that the recited "application programs" are not readable on the Dobbs printer driver, as the former is an application-level program and the latter is a system-level program.

However, it is not clear that the recited "application programs" are limited in such a way as to preclude this term from being read on a system-level program that is used for the application of converting a stored file into a form understood by a printer (that being the description of the "printer driver" of Dobbs).

Applicant argues (7/9/04 Response: page 9, line 13 - p[age 10, line 2) that Koppolu and Weinberger are not related to the testing of a print driver.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In the present case, as noted above, the Dobbs reference teaches (column 2, lines 12-61) the testing of a print driver. This portion of Applicant's argument does not address the Dobbs reference individual or the propriety of the combination of the Dobbs reference with the teachings of Koppolu and Weinberger.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

Art Unit: 2624

expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 703-305-4390. The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2600 Customer Service center at 703-306-0377.

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 703-308-7452.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 703-872-9306.

Art Unit: 2624

Hand-carried or courier-delivered correspondence pertaining to this application should be directed to

US Patent and Trademark Office
220 South 20th Street
Crystal Plaza Two, Lobby, Room 1B03
Arlington VA 22202

Stephen M Brinich
Examiner
Art Unit 2624

smb *Smb*
September 23, 2004



Thomas D
~~THOMAS D~~ LEE
PRIMARY EXAMINER